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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------|-------------|----------------------|---------------------|------------------|
| 10/584,436 | 06/22/2006 | Sabrina John | VOS0067/US | 4128 |
| 33072 | 7590 | 11/19/2008 | EXAMINER | |
| KAGAN BINDER, PLLC | | | HOFFMAN, SUSAN COE | |
| SUITE 200, MAPLE ISLAND BUILDING | | | | |
| 221 MAIN STREET NORTH | | | ART UNIT | PAPER NUMBER |
| STILLWATER, MN 55082 | | | 1655 | |
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| | | | 11/19/2008 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/584,436 | JOHN, SABRINA | |
| | Examiner | Art Unit | |
| | Susan Coe Hoffman | 1655 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 August 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 3-7, 16, 17 and 19-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 3-7, 16, 17, 19-22 and 24-27 is/are rejected.
- 7) Claim(s) 23, 28 and 29 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. The amendment filed August 12, 2008 has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claims 8-15 and 18 have been cancelled in this amendment.
3. Claims 19-29 have been added in this amendment.
4. Claims 3-7, 16, 17, and 19-29 are pending.
5. In the reply filed on December 26, 2007, applicant elected group I without traverse. The claims drawn to the other group of invention have been cancelled.

Claim Rejections - 35 USC § 112

Claims 3-7, 16, 17, 21, 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 3 is considered indefinite because it is unclear what potencies of tyrosinase inhibitors are encompassed by "potent." In addition, it is unclear what amounts of tyrosinase inhibitors are encompassed by "substantially free."
7. Claim 21 is indefinite because it adds an additional depigmentation agent to the composition of claim 19. This is improper because the composition of claim 19 is claimed as "consisting of" Bellis perennis. The use of "consisting of" limits the composition to only one depigmenting agent, specifically B. perennis. Thus, the inclusion of an additional depigmenting agent causes a conflict in scope between claim 21 and claim 19. This conflict in scope causes confusion as to the actual scope of claim 21.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 3-6, 19-22 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 2003-002811 (translation provided).

JP '811 teaches a cosmetic composition which contains an extract of *B. perennis* as an active ingredient (see paragraph 31 of the translation). The composition contains between 0.01 to 10% of the active ingredient. The cosmetic is formulated with antioxidants into forms such as lotions, creams, ointments, and solutions (see paragraphs 66 and 67 of the translation).

The reference does not specifically teach that the cosmetic depigments the skin. However, all skin contains pigmentations and melanin and contains the enzymes, such as tyrosinase, that are inhibited by the claimed extract as disclosed in applicant's specification. Thus, the reference method inherently anticipates the claimed method because depigmentation of the skin would naturally occur when the reference cosmetic containing *B. perennis* is placed in contact with the pigmented skin. The reference also does not specifically teach including potent tyrosinase inhibitors or other depigmenting ingredients in the cosmetic. Thus, the claims are considered to properly anticipate applicant's claimed invention.

9. Claims 3-6, 16, 19-22, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2001-122730 (translation provided).

JP '730 teaches a cosmetic composition which contains an extract of *B. perennis*. The composition is formulated with surfactants and antioxidants such as vitamin E (see paragraphs 8, 12, 22 and 23 of the translation). The reference includes a specific example with 1.4% of the daisy (*B. perennis*) extract (see paragraph 88). 1.4% is considered to be encompassed by "about 2%" as claimed by applicant.

The reference does not specifically teach that the cosmetic depigments the skin. However, all skin contains pigmentations and melanin and contains the enzymes, such as tyrosinase, that are inhibited by the claimed extract as disclosed in applicant's specification. Thus, the reference method inherently anticipates the claimed method because depigmentation of the skin would naturally occur when the reference cosmetic containing *B. perennis* is placed in contact with the pigmented skin.

JP '730 does teach the inclusion of whitening agents and tyrosinase inhibitors in the cosmetic composition (see paragraphs 43 and 44). However, these agents are listed as part of a laundry list of numerous known cosmetic agents. There is no specific teaching that would require the inclusion of the whitening agents with the *B. perennis*. Thus, the reference is considered to properly anticipate the stated claims because the inclusion of whitening agents is not required.

Claim Rejections - 35 USC § 103

10. Claims 3, 4, 6, 16, 17, 19, 20, 22, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2003-002811.

The teachings of this reference are discussed above. The reference does not specifically teach formulating the composition into all of the compositions claimed by applicant in claims 4 and 20. However, these are all well known cosmetically acceptable forms. An artisan of ordinary skill would be motivated to employ these well known forms while making the cosmetic composition taught by JP '811.

The reference also does not specifically teach using the *B. perennis* in the amounts claimed by applicant. However, as discussed above, the reference does teach using active ingredients in amounts from 0.001% to 10%. Therefore, an artisan of ordinary skill would reasonably expect that using concentrations of *B. perennis* within these percentages would be useful in the cosmetic method taught by the reference. This reasonable expectation of success would motivate the artisan to use these concentrations of *B. perennis*.

11. Claims 3, 4, 6, 16, 17, 19, 20, 22, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-122730.

The teachings of this reference are discussed above. The reference does not specifically teach formulating the composition into all of the compositions claimed by applicant in claims 4 and 20. However, these are all well known cosmetically acceptable forms. An artisan of ordinary skill would be motivated to employ these well known forms while making the cosmetic composition taught by JP '730.

The reference also does not specifically teach using the *B. perennis* in the amounts claimed by applicant. However, as discussed above, the reference does teach using the daisy in amounts at 1.4%. Therefore, an artisan of ordinary skill would reasonably expect that using concentrations of *B. perennis* around this percentages would be useful in the cosmetic method

taught by the reference. This reasonable expectation of success would motivate the artisan to use these concentrations of B. perennis.

Allowable Subject Matter

12. Claims 23, 28 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claims 7, 26 and 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe Hoffman whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday-Thursday, 9:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susan Coe Hoffman/
Primary Examiner, Art Unit 1655